

REMARKS

Claims 1, 3 to 36, 38 to 48 and 50 to 75 are pending. The Examiner withdrew claims 7 to 11, 30 to 32, 34, 39 to 41, 44, 54 to 58, 66 to 68, 70, and 73 to 75 as being drawn to a non-elected species. Claims 1, 3 to 6, 12 to 29, 33, 35, 36, 38, 42, 43, 45 to 48, 50 to 53, 59 to 65, 69, 71, and 72 will be under examination.

The Examiner rejected claims 1, 3 to 6, 12 to 17, 29, 33, 35, 36, 38, 42, 43, 45 to 48, 50 to 53, 59 to 65, 69, 71 and 72 as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,979,951 to Simpson and has rejected claims 18 to 28 under 35 U.S.C. § 103(a) as unpatentable over Simpson. Applicant notes that the present rejection substantially repeats the rejection of the claims made in the July 14, 2008 Office Action. Applicant responded to that Office Action on October 14, 2008. The Examiner, however, states that the Applicant's response was not persuasive and requests some further explanation of why Applicant believes the claimed features are not present in Simpson. Applicant respectfully traverses this rejection of the claims for the reasons set forth below.

The Examiner states that Simpson teaches a catheter (in FIG. 3) having a first elongate tubular body (108), a second elongate tubular body (101a), a third elongate member (cutter 106 and drive cable 116) and an elongate member (101, only the section with notch 102). Each of the independent claims 1, 36, 42, 43, 45, and 72 recite features that are neither disclosed by Simpson nor obvious over Simpson. Specifically, as Applicant has previously pointed out, claim 1 is directed to a catheter having first, second and third elongate tubular bodies and recites that the third elongate tubular body is "moveable over a limited range of motion from a proximal position where the distal end of the third elongate tubular body is proximal of the proximal end of the second elongate tubular body to a distal position where the distal end of the third elongate tubular body is distal of

the proximal end of the second elongate tubular body” and “wherein the proximal end of the third elongate tubular body is maintained within the lumen of the first elongate tubular body over the entire limited range of motion”. Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies having the features required by claim 1. Specifically, the proximal end of drive cable 116 which the Examiner identifies as the proximal portion of the third elongate member is not maintained within the lumen of tube 108 over the entire limited range of motion of the third elongate member. See, for example, Simpson at Col. 7, lines 2 to 7 which compares the embodiment of FIG. 3 with that of FIG. 1 and states that the tube 108 can be secured to the leg 48 of the U-shaped member 47 in the same manner that the guiding cable 36 is secured thereto. Similarly, cable 116 can be secured to the knob 52 in the same manner that the flexible guide means 41 is secured to the knob 52 (See, FIG. 1). Since cable 116 is secured to knob 52 it is clear that its proximal end can not be maintained within the lumen of tube 108 since, as described and shown in FIG. 1, the proximal end of cable 116 must extend past the proximal end of tube 108 in order for the connection to knob 52 to be made. Therefore, Simpson does not anticipate claim 1.

Claim 36 is directed to a catheter having first, second and third elongate tubular bodies and recites that the third elongate tubular body is “configured to move between a first proximal position and a second distal position, the distal end of the third elongate tubular body being between the distal end of the first tubular body and the proximal end of the second tubular body when the third elongate tubular body is in the first proximal position and being within the lumen of the second tubular body when the third elongate tubular body is in the second distal position” and “wherein the proximal end of the third elongate tubular body is maintained within the lumen of the first elongate tubular body when the third elongate tubular body is in the first proximal position and when the third elongate

tubular body is in the second distal position”. Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies having the features required by claim 36. Specifically, as described above in connection with claim 1 the proximal end of cable 116 extends past the proximal end of tube 108. Therefore, the proximal end of cable 116 is not maintained within the lumen of tube 108 when the cutter 106 moves from a proximal position to a distal position as required by claim 36. For at least this reason Simpson does not anticipate claim 36.

Claim 42 is directed to an assembly for delivering a catheter having first, second and third elongate tubular bodies and recites that the third elongate tubular body is “moveable over a limited range of motion from a proximal position where the distal end of the third elongate tubular body is proximal of the proximal end of the second elongate tubular body to a distal position where the distal end of the third elongate tubular body is within the lumen of the second elongate tubular body and where the proximal end of the third elongate tubular body is within the lumen of the first elongate tubular body”. Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies having the features required by claim 42. Specifically, as described above with respect to claims 1 and 36 the proximal end of cable 116 does not lie within the lumen of tube 108, and therefore, can not be maintained within the lumen of tube 108 when the distal end of cutter 106 is within the second elongate tubular body (101a). For at least this reason claim 42 is not anticipated by Simpson.

Claim 43 is directed to an assembly comprising an embolic protection device and a catheter, the catheter having first, second and third elongate tubular bodies and recites that the lumen of the third elongate tubular body is “sized to contain the embolic protection device”, the third tubular body is “configured to be slideable from a first position where the second and third tubular bodies are not

abutting each other to a second position where the second and third tubular bodies are abutting each other”, where the embolic protection device is “moveable from the lumen of the third elongate tubular body to the lumen of the second elongate tubular body when the third elongate tubular body is in the second position”, and where the “proximal end of the third elongate tubular body is maintained within the lumen of the first elongate tubular body in both the first and second positions”. Simpson does not disclose or teach an assembly including an embolic protection device and a catheter having first, second and third elongate tubular bodies having the features required by claim 43. Specifically, neither cutter 106 nor cable 116 have a lumen sized to contain an embolic protection device. Further, Simpson does not disclose an embolic protection device that is moveable from the lumen of the cutter 106 (or cable 116) to the lumen of the second elongate body 101a. Still further, as described above with respect to claims 1, 36 and 42 the proximal end of cable 116 does not lie within the lumen of tube 108, and therefore, can not be maintained within the lumen of tube 108 when the cutter 106 is in a first position or a second position. For at least these reasons claim 43 is not anticipated by Simpson.

Claim 45 is directed to a method for positioning a catheter and includes providing a catheter having first, second and third elongate tubular bodies and recites that the third elongate tubular body is “moveable over a limited range of motion from a proximal position where the distal end of the third elongate tubular body is proximal of the proximal end of the second elongate tubular body to a distal position where the distal end of the third elongate tubular body is distal of the proximal end of the second elongate tubular body” and “wherein the proximal end of the third elongate tubular body is maintained within the lumen of the first elongate tubular body over the entire limited range of motion”. Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies

having the features required by claim 45. Specifically, these limitations are similar to those discussed above with respect to claim 1 and the discussion there is equally applicable to claim 45. Claim 45 is allowable for at least the same reasons as claim 1.

Claim 72 is directed to a method for positioning a catheter within a patient's blood vessel and includes providing a catheter having first, second and third elongate tubular bodies and recites that the third elongate tubular body is "configured to move between a first proximal position and a second distal position, the distal end of the third elongate tubular body being between the distal end of the first tubular body and the proximal end of the second tubular body when the third elongate tubular body is in the first proximal position and being within the lumen of the second tubular body when the third elongate tubular body is in the second distal position" and "wherein the proximal end of the third elongate tubular body is maintained within the lumen of the first elongate tubular body when the third elongate tubular body is in the first proximal position and when the third elongate tubular body is in the second distal position". Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies having the features required by claim 72. Specifically, as described above in connection with claims 1 and 36 the proximal end of cable 116 extends past the proximal end of tube 108. Therefore, the proximal end of cable 116 is not maintained within the lumen of tube 108 when the cutter 106 moves from a proximal position to a distal position as required by claim 72. For at least this reason Simpson does not anticipate claim 72.

Based on the foregoing Applicant respectfully submits that claims 1, 36, 42, 43, 45, and 72, the only remaining independent claims, are allowable and requests that the rejection of those claims be withdrawn. Remaining claims 3 to 6, 12 to

17, 29, 33, 35, 38, 42, 46 to 48, 50 to 53, 59 to 65, 69 and 71 depend from these claims and are allowable for at least these same reasons.

The Examiner has rejected claims 18 to 28 under 35 U.S.C. § 103 as being unpatentable over Simpson. Claims 18 to 28 depend from claim 1 and add further limitations. These claims are allowable for at least the same reasons as claim 1.

In view of the remarks above, Applicant respectfully requests that the Examiner withdraw this rejection of the claims.

If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

Date: December 18, 2008

By /Terry L. Wiles/
Customer No. 009561
Terry L. Wiles (29,989)
Patrick J. O'Connell (33,984)
Popovich, Wiles & O'Connell, P.A.
650 Third Avenue South, Suite 600
Minneapolis, MN 55402
Telephone: (612) 334-8989
Attorneys for Applicant
twiles@pwolaw.biz